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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,242	01/09/2004	Mark Robert	715 P 025	7772
7590 12/01/2006 Monique A. Morneault, Esq. Wallenstein Wagner & Rockey, Ltd. 53rd Floor 311 South Wacker Drive Chicago, IL 60606-6630			EXAMINER STULII, VERA	
			ART UNIT 1761	PAPER NUMBER
DATE MAILED: 12/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/754,242

Applicant(s)

ROBERT, MARK

Examiner

Vera Stulii

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 05/11/2005, 04/26/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specification discloses presence of stabilizers in claimed invention. It was well known in the art that disclosed stabilizers provide emulsifying properties as well as stabilizing properties. Specification does not provide examples or guidance regarding a product without an emulsifier.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 6 and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, the phrase "preferred sources" renders the claim indefinite because it is unclear whether cream or milk are required or optional.

In regard to claims 6 and 14, the recitation of a selection from a group of elements in a claim should comply with accepted U.S. Patent practice with regard to the recitation of Markush grouping of claim elements. Phrases using "comprising" are open sets, and should recite elements in the alternative (i.e. "comprising A, B, C or D"), whereas closed sets ("consisting of") should recite elements as "selected from the group consisting of A, B, C and D."

Claim 10 recites absence of emulsifier and presence of stabilizer. Claim 16 recites carrageenan and guar gum as examples of stabilizers. It was well known in the art that carrageenan and guar gum provide emulsifying properties as well as stabilizing properties. Therefore elimination of emulsifiers conflicts with presence of stabilizers i.e. gums which may act as emulsifiers.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hussein (US 6,197,362).

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In regard to claims 1-9, Hussein discloses pourable dessert liquid product comprising from about 2 weight % to about 20 weight % milk solids nonfat (Col. 1 lines 58-59), from about 4 weight % to about 35 weight % sweetener (Col.2 lines 4-5), from about 1 weight % to about 15 weight % of fat (Col.1 line 64-65), from about 0.01 weight % to about 2.0 weight % of stabilizer (Col.2 line 11-16), from about 0.1 weight % to about 2 weight % of flavoring agent (Col.2 lines 17-23).

In regard to claim 2, Hussein discloses that milk solids nonfat include dried skim milk, whey protein and milk protein concentrate (Col.1 line 58-59).

In regard to claims 3 and 4, Hussein discloses dairy fats, dairy crèmes, and the like (Col.2 lines 1-2).

In regard to claim 5, Hussein discloses sweeteners such as sucrose and corn syrup (Col.2 lines 7-10).

In regard to claim 6, Hussein discloses high fructose corn syrup, sucrose, dextrose, and corn syrup (Col. 2 lines 7-10).

In regard to claim 7, Hussein discloses stabilizers such as carrageenan, guar gum, locust bean gum, xanthan gum, cellulose, modified cellulose, hydrocolloids and the like (Col. 2 lines 11-16).

In regard to claim 8, Hussein teaches that the pourable dessert product may be incorporated into food products where condensed and/or evaporated milk is called for such as custards, creme brulee and the like (Col. 2 lines 35-37). It is also noted that Hussein teaches use of dairy crèmes (Col.2 lines 1-2) as a fat component for pourable

dessert. Therefore the resulting product comprises combination of dairy crème, evaporated milk, and condensed milk, which makes it "tres leches" dairy mix.

In regard to claim 9, Hussein discloses soaking a suitable cake with an appropriate amount by weight of the pourable dessert liquid mix (Col.2 lines 49-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hussein (US 6,197,362) in view of Dairy Foods.

Hussein is taken as cited above.

It is noted that claim 10 recites absence of emulsifier and presence of stabilizer.

In the same time, claim 16 recites carrageenan and guar gum as examples of stabilizers. It was well known in the art that carrageenan and guar gum provide

emulsifying properties as well as stabilizing properties. Therefore elimination of emulsifiers conflicts with presence of stabilizers i.e. gums which may act as emulsifiers.

Hussein does not disclose absence of emulsifier.

Dairy Foods discloses that consumers distrust and avoid "chemical sounding" names of food ingredients (p. 1 § 4). Dairy Foods discloses that polysorbate 80 possibly causes cancer (p. 1 § 2). Dairy Foods also disclose that a stabilizer/emulsifier blends have been developed that can eliminate polysorbate 80 from dairy food formulations, while maintaining or even improving finished product quality (p. 1 § 4). Dairy Foods also disclose that the new stabilizer/emulsifier blends replaced emulsifying system in a range of frozen dairy desserts, including traffic brand and premium ice cream, ice milk, frozen yogurt and sugar-free products (p. 1 § 5). Dairy Foods also disclose that ingredients such as "locust bean gum, cellulose gum, guar gum and carrageenan" are used in the new emulsifying blends. Since Hussein discloses use of ingredients such as carrageenan, guar gum, locust bean gum, etc. (Col. 2 lines 11-16), and Dairy Foods teaches use of locust bean gum, cellulose gum, guar gum and carrageenan in emulsifying blends, it would have been obvious to one skilled in the art to employ locust bean gum, cellulose gum, guar gum and carrageenan as an emulsifying blend in order to remove "chemically sounded" ingredients and still maintain or even improve finished products quality as taught by Dairy Foods.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Stulii whose telephone number is (571) 272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VS


KEITH HENDRICKS
PRIMARY EXAMINER